

CLAIM REJECTIONS – 35 USC § 112

The Examiner also issued a rejection of claims 1-5 pursuant to 35 U.S.C. § 121 requiring the Applicant to be more definite in claims 1-5 in regard to claiming the tensioner and surgical tape. Claim 1 is hereby amended to fully respond to such rejection, and such amended claim 1 is shown under the section entitled “Amendments” below. Claim 1 is amended to clarify that the claimed device is the tensioner and not the *combination* of tensioner and surgical tape.

Specifically, the Applicant has modified the language referring to a tensioner being attached to surgical tape from “restrainably engages” to “can restrainably engage”. Such change makes the language more definite such that it is clearer that the Applicant is claiming a tensioner having a “body” where this body has certain features such as, but not limited to, being able to attach to surgical tape.

Claims 2-5 depend upon claim 1 and therefore are more definite due to the amendment made to claim 1, and thus do not require amendment. Applicant therefore respectfully requests Examiner to withdraw the rejection based on indefiniteness under 35 U.S.C. § 112 for claims 1-5.

CLAIM REJECTIONS 35 USC § 102

The Examiner has rejected claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by Smith (U.S. Patent No. 4,140,125). This rejection is respectfully traversed. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Examiner alleges that Smith '125 teaches "a tensioner for surgical tape." However, Smith '125 does not teach a "unitary tensioner body," but a "surgical tape device" (Col. 1, line 40) or a "surgical tape" (Col. 3, line 22) which is a thin tube or thread-like material. The proposed invention discloses a tensioning device, not a surgical tape.

Smith '125 additionally teaches a "clamping pad" (Col. 5, line 35) which may be attached to surgical tape by a "clamping jaw portion." However, even though the "clamping jaw" has an "opening" (Col. 5, line 44) in the hinged portion of the device where such opening may be analogous to the somewhat circular opening **502** in **Figure 5** of the pending application, the tensioning device disclosed in the pending application has many features or elements which are substantially different from those elements of the device disclosed in Smith '125.

First, the Smith '125 device does not teach a "slot" to receive a free end of surgical tape. The Smith '125 device requires that a free end of surgical tape must be forced in between the two jaw members of the clamping jaw (Col. 6, lines 34-38). Alternatively, Smith '125 requires that the jaws must be opened, a strand of surgical tape inserted, and the jaws closed upon the strand of tape. The proposed invention discloses a tensioning device having a rigid, formed slot (**506** in **Figure 5**) whereby a strand of surgical tape may be easily inserted into the slot and a proper amount of tension applied to the tape. A pre-formed slot is substantially different than the naturally occurring opening between two halves of a closing jaw device.

Second, the Smith '125 device does not have a "slot" in connection with a first opening. The Smith '125 device has a division between two parts, not a pre-formed opening sized for surgical tape with features designed to attach to the tape. Such slot (**504** in **Figure 5**) of the proposed invention in the pending application provides the benefit of allowing a user to separately give tension to the attached end of a strand of surgical tape. The slot **504** allows the attached strand of tape to be temporarily released into the connected opening (**502** in **Figure 5**), allows the strand to be adjusted, and then allows the strand to be re-attached by the moving the

strand back into the slot.

Finally, the proposed invention does not have small parts which may be lost during a surgical procedure, and the proposed invention has no moving parts. The two slots of the proposed invention allow easier facility by a surgeon or other user when working with such a device. The Smith '125 device may more easily break at the hinge from repeated use. The proposed invention is unitary and thus has no parts prone to breaking due to mechanical fatigue.

The Smith '125 device is also prone to failure in gripping a strand of tape because the two jaw members must be closed and aligned properly during use. The proposed invention is unitary device with no moving parts thereby having less chance of failure to grip a strand of tape. Therefore, Applicant respectfully requests Examiner to withdraw the rejection of anticipation by Smith '125 of claims 1-13.

The examiner also rejected claims 1-3, 5-7, 9 and 10 under 35 U.S.C. § 102(b) as being anticipated by Bierman (U.S. Patent No. 5,354,282). This rejection is respectfully traversed.

Examiner alleges that teaches the proposed invention, namely, a tensioner having an attaching means, a holding means, and elongated slots. The Examiner alleges that the device in Bierman '282 discloses a "slide clamp." However, the Examiner neglects to consider the language found in the disclosure of Bierman '282. The device of the proposed invention is a "tensioner" which must hold a surgical tape without slipping. Proposed claim 1 contains the language "attached" in reference to surgical tape, not "slideably attached" or other such language. The clamp of Bierman '282 includes a pair of prongs and an aperture (Col. 8, lines 63-67), but such device "slides over the tube" even while the tube is within the tapered portion of the slot (Col. 8, lines 5-7). The Bierman '282 device thus teaches away from using a slot to maintain a grip on a tape, thread, tube or other object. The Bierman '282 device is designed to stop fluid flow within a tube, not to hold a tube without slipping (Col. 8, lines 4-5).

Further, the proposed invention has two slots, one for each end of a piece of surgical tape which may be positioned around an anatomical vessel or protrusion. The clamp of Bierman '282 has just one slot wherein a tube is passed one time through the slot or opening. The proposed invention is therefore substantially different from the clamp disclosed in Bierman '282 having substantially different elements as found in the language of the claims of the proposed invention. Therefore, Applicant respectfully requests Examiner to withdraw the rejection of anticipation by Bierman '282 of claims 1-3, 5-7, 9, and 10.

CLAIM REJECTIONS 35 USC § 103

The Examiner has rejected claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Bierman (U.S. Patent No. 5,354,282) due to obviousness. This rejection is respectfully traversed. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141; *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Examiner alleges that it would have been obvious to a person having ordinary skill in the art to use a circular opening in place of a generic opening as disclosed by Bierman '282. Since dependent claims have all of the limitations of the independent claims from which they depend, claims 4 and 8 contain all of the limitations contained in claims 1 and 6, respectively. As explained previously, claims 1 and 6 are patently distinguishable over Bierman '282. The clamp of Bierman '282 includes a pair of prongs and an aperture (Col. 8, lines 63-67), but such device "slides over the tube" even while the tube is within the tapered portion of the slot (Col. 8, lines 5-7). The shape of the tapered portion is not circular but having straight sides such as in the shape of a "V" to create a taper. The Bierman '282 device thus appears to teach away from using a rounded opening toward the wider end. The language of Bierman '282 does not specifically mention a circular opening in reference to the opening in the slide clamp. Further, the opening of the slide clamp shown in Fig.1 of Bierman '282 is not circular. The opening of the clamp as disclosed in the Bierman '282 patent is meant to allow the clamp to moveably slide along the tube. The language in the proposed claims 1 and 6 refer to an attachment and a restrainably engaged opening for surgical tape. Therefore, since claims 1 and 6 are distinguishable over Bierman '282, claims 4 and 8 are likewise patently distinguishable and non-obvious over

Bierman '282. Therefore, Applicant respectfully requests Examiner to withdraw the rejection of obviousness because of Bierman '282 for claims 4 and 8.